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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,162	02/15/2001	Robert Anthony Luciano JR.	GSS-00-001-CIP.1	4032

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EXAMINER	
ENATSKY, AARON L	

ART UNIT	PAPER NUMBER
3713	

DATE MAILED: 03/01/2004 10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/788,162	Applicant(s) LUCIANO ET AL.	
	Examiner Aaron L Enatsky	Art Unit 3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 January 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *134-142,145-147 and 150-152* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *134-142,145-147 and 150-152* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Examiner acknowledges receipt of amendment on 01/24/03. The arguments set forth in the response are addressed herein below. Rejections based upon this prior art are contained herein below. Furthermore, the prior art rejections of record are being maintained for the reasons set forth in the response to argument section herein.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 134-142, 144-147, and 151-152 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US Patent No. 6,165,071 to Weiss. Weiss teaches a game system that allows a player to play a game over many sessions (Abstract). A player is given the ability to discontinue game play at this own whim as a function of time (1:59-67) and additionally, through the use of memory cards, hold game state data with player information (2:25-37). This information can be encrypted and stored on the memory cards for later use when restoring a game (2:25-37). Weiss also discloses that a memory card can hold data regarding use in specific machines, such as a machine exclusively calibrated for baseball (4:53-58), which meets the limitation of a gaming device restriction.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 150 is rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss. In regard to claim 150, Weiss teaches the limitations as discussed above, but does not expressly teach indicating null or any state for an element that is lacking any data. However, Weiss provides for variable states of identified elements in a game where these states allow for constant analysis to determine award benefits to players for their achievements (2:15-19 and 5:30-58). The constant analysis would not include elements that have not produced tangible data for analysis, such as post-season performance if the analysis is performed during a regular season. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide some data state indicating the lack of data for that element so that improper data is not used. Furthermore, it is notoriously well known in the art of data management to use *NULL* identifiers to indicate lack of data in a data field to speed data processing.

Response to Arguments

Applicant's arguments filed 01/24/03 have been fully considered but they are not persuasive. Applicant has amended claims to include the limitations of data comprising certain features and recited the feature of a game based upon a random event. Applicant's amendments also cancel claims 143-144 and 148-149.

Re *a game based upon a random event*: In response to applicant's arguments, the recitation "configured to enable play of a game whose outcome is based at least partially on a random event" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Assuming arguendo, Examiner believes Weiss also teaches the limitations of a game based at least partially on a random event. Applicant believes that Weiss is directed solely to sports types games and thus does not encompass game based upon random events. However, Examiner is of the mindset that wagering on sports games is in fact, wagering on random events. The nature of sports, while relying on individual's abilities or that of a group, does not detract from the unpredictability of the outcome. A game's unpredictability lends to the randomness of the apparent outcome. Randomness is also viewed as a probability of the occurrence of events. A participant in a sports event, such as basketball, might have a high percentage of completed free throws, but there is no guarantee that the participant will always make a free throw. Because the participant makes a high number of free throws, the probability might be in his favor that a future free throw will good, but the chance exists that he will miss. A player in Weiss invention can wager on all aspects of a sports game (2:16-37), which would be a game based upon the random occurrence of events.

Re *data comprising certain game limitations*: Examiner has pointed to a particular location in Weiss that discloses at least one data element of a gaming device restriction.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. No. 6,015,344 to Kelly et al. teaches player game media with memory for storing player tracking data as well as promotional data.

US Pat. No. 5,770,533 to Franchi teaches a network casino system that uses player-tracking data.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8-6 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg can be reached on 703-308-1327. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ALE

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